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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,175	11/17/2003	William C. Paske	HO-P02511US1	4093
26271	7590	10/05/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			NGUYEN, HUONG Q	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,175

Applicant(s)

PASKE ET AL.

Examiner

Helen Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 28-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/26/2004, 10/29/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention 2, **Claims 17-27** in the reply filed on 9/11/2006 is acknowledged.
2. **Claims 1-16 and 28-39** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged, namely, priority to provisional application #60427393, filed on 11/19/2002.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 2/26/2004 and 10/29/2006 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. **Claims 26-27** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claims 26-27 recite the limitation "said fixture" with insufficient antecedent basis for the limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 17-26** are rejected under 35 U.S.C. 102(b) as being anticipated by Paske (US Pat No. 6231525).

10. In regards to **Claim 17**, Paske discloses a method of determining the presence or absence of neural, muscular, soft tissue, bone or joint damage to the wrist complex comprising the steps of: (a) engaging contact points with at least one digit innervated by the ulnar nerve and at least one digit innervated by the median nerve, wherein the contact points are configured to transmit forces normal to their surface; (b) applying force on the contact points with said digits; and (c) measuring the force applied to at least two of said contact points to provide quantifiable outputs

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therefor, wherein the outputs are used to diagnose wrist complex diseases and injuries (Col.10, line 52-67; Col.11, line 1-5).

11. In regards to **Claim 18**, Paske discloses the quantifiable outputs representing the forces applied by at least two digits innervated by different nerves are displayed, such as in Figure 5b.

12. In regards to **Claim 19**, Paske discloses the outputs are displayed as a function selected from the group consisting of time, frequency, phase, and any combination thereof, such as in Figure 4a and 4b.

13. In regards to **Claim 20**, Paske discloses the measurements are processed by a computer for storage or immediate use (Col.6, line 66-67; Col.7, line 1).

14. In regards to **Claim 21**, Paske discloses the diseases and injuries are diagnosed using a technique selected from the group consisting of pattern recognition, neural networks, frequency analysis, phase analysis, signature analysis, graphic displays, and any combination thereof (Col.9, line 1-7).

15. In regards to **Claim 22**, Paske discloses the measurements are compared to earlier measurements at a frequency selected from the group consisting of hourly, daily, weekly, yearly and any combination thereof to determine long term effects of said diseases or injuries (Col.5, line 7-10).

16. In regards to **Claim 23**, Paske discloses the force is applied to said contact points for a prolonged period of time (Col.11, line 6-7).

17. In regards to **Claim 24**, Paske discloses the force is applied repeatedly to said contact points (Col.7, line 6-10).

18. In regards to **Claim 25**, Paske discloses a visual or audible signal is produced when force should be applied to said contact points (Col.12, line 3-5).

19. In regards to **Claim 26**, Paske discloses said contact points are provided on a fixture that allows displacement measurements to be made (Col.4, line 65-67; Col.5, line 1-3).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over Paske. Paske discloses applying a force normal to the surface of the contact points but does not explicitly disclose said normal force as 70% of the total force. However, because Paske discloses applying normal force and applicant has not expressed criticality in the specification as to the amount of

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normal force applied in relation to the total force, it seems that any amount of normal force would be sufficient in the operation of said invention. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Paske such that the normal force applied to the surface of the contact points is at least 70% of the total force because such modification would have been considered a mere design consideration which fails to patentably distinguish over Paske.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paske (US Pat No. 6264621) discloses a system and method for providing quantified and qualitative hand analysis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Nguyen whose telephone number is 571-272-8340. The examiner can normally be reached on Monday - Friday, 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HQN
9/22/2006

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